

foregoing amendment and the following remarks.

Respectfully, and generally for the reasons set forth below, the objections and rejections and each ground therefor are traversed. Generally, it is believed that the amendment adds no new matter.

**A. Paragraphs of Objections and/or Rejections**

**1. Paragraphs 1-4 of the Office Action**

In paragraphs 1-4 of the Office Action, the Examiner has recited the restriction requirement and election in the present case and required confirmation of the election.

In response, the undersigned confirms that the Examiner has correctly reported the election without traverse of claims 5-24.

**2. Paragraphs 5-8 of the Office Action**

In paragraphs 5-8 of the Office Action, the Examiner has objected to the drawings and required new formal drawings, noted a misnumbered reference numeral 54 on page 12, noted a missing reference numeral 36 in FIG. 3, and required showing "locating the rain gear, as the article, within the hollow of the replica."

In response, new formal drawings are being filed herewith, the misnumbered reference numeral has been corrected by the foregoing amendment, the missing reference numeral has been added, and the "locating the rain gear, as the article, within the hollow of the replica" has been added.

**3. Paragraph 9 of the Office Action**

In paragraph 9 of the Office Action, claims 5-23 have been objected to on grounds of 35 USC Sec. 112. The Examiner contends that in claims 5-22, the element "constructing essentially a replica of a symbol having a shape that is suggestive of an activity" is vague and indefinite; and "constructing...capable of receiving writing" is indefinite as anything could be so constructed.

In response, claims 5 and 23 have been amended to clear up the cited indefiniteness. With respect to this ground of rejection and those in paragraphs 12-16, it is respectfully submitted that the rejections are premised upon a misinterpretation of the claims. The Examiner contends, at page 4 of the Office Action, that "symbols include

such things as crosses or letters, are not described in the specification or shown in the drawing." The contention is respectfully traversed as premised on a misunderstanding of the claims. The Examiner's attention is drawn to the specification, page 4, lines 15-17, wherein the following is stated: "The process for making structural indicia packaging can be described as having the steps of selecting a **symbol or icon** having a shape that suggests an activity (such as selecting a golf ball to suggest playing golf)." A golf ball is shown in FIG. 6. The specification shows the claimed method step with an illustrative symbol, and it is respectfully submitted that not every symbol need be set forth in the specification in order to teach the method step.

Further, the term "symbol" has a plain, common, and ordinary meaning reflected, for example, in Webster's Ninth New Collegiate Dictionary, wherein the term is defined as: "suggests something else by reason of relationship, association, convention, or accidental resemblance." So, for example, a golf ball is symbolic of the game of golf (by reason of association). See enclosed excerpt from Webster's dictionary.

**4. Paragraph 11 of the Office Action, Etc.**

**a. GELINAS Does Not Teach the Claimed  
"symbol and that is suggestive..."**

In paragraph 11 of the Office Action, claims 5, 8, 9 and 11-14, 16, 18-21 and 23 have been rejected pursuant to 35 USC Sec. 102(b). The Examiner contends that the claims are anticipated by GELINAS.

It is respectfully submitted that the Office Action is not clear as to how the claims are being interpreted, and the result is that Applicant is speculating as to how the references are being applied in rejecting the claims. If Applicant's speculations are incorrect, an opportunity to respond is requested.

The Examiner contends that GELINAS discloses a package that is a replica of a golf ball, a base ball, a football, tennis ball, soccer ball or rugby ball (Figures 1-9)." However, one shape cannot possibly be symbolic of both a golf ball and a foot ball, for example. The Examiner's contention reveals that GELINAS's shape is ambiguous.

GELINAS discloses what appears to be a body 12. However, body 12

appears to be of a generally shape--perhaps spherical. The general shape is not recognizable as an icon or symbolic of anything in particular. See the instant specification at page 13, lines 9-14: "Mere amorphous shapes such as a cylindrical or cubical box will not suffice because the generic shape would communicate no information concerning the content of a container...." GELINAS does not teach the claimed step of constructing a replica of a symbol or icon that is suggestive, as is more precisely set out in the claims.

**5. Paragraph 12 of the Office Action, Etc.**

**a. AGAPIOU Does Not Teach the Claimed  
"article being useful in connection with  
the activity suggested by the shape ..."**

In paragraph 12 of the Office Action, claims 5, 17, and 22 have been rejected pursuant to 35 USC Sec. 102(b). The Examiner contends that the claims are anticipated by AGAPIOU.

It is respectfully submitted that the Office Action is not clear as to how the claims are being interpreted, and the result is that Applicant is speculating as to how the references are being applied in rejecting the claims. If Applicant's speculations are incorrect, an opportunity to respond is requested.

From the Office Action, as it is understood, the Examiner apparently contends that AGAPIOU teaches "packaging" i.e., container 10; that AGAPIOU discloses packaging that is "symbolic" of a tire (Col. 2, line 4); and that the container 10 is "suggestive" of activities involving use of a tire; and that AGAPIOU also teaches an "article" located in the "packaging," i.e., a "toy figure(s) 12 to be used in the kit may have any desired animal-like appearance." However, if this is the contention being made in the Office Action, then AGAPIOU can not be interpreted as teaching the claimed "the article being useful in connection with the activity suggested by the shape" because AGAPIOU does not teach that the toy is not useful with activities involving use of the tire. AGAPIOU appears to envision that the toy is useful with the container.

The Examiner further contends that AGAPIOU teaches a logo and a package is capable of receiving writing. The logo is not raised, as is claimed, and the writing appears to be printing, presumably during the manufacturing of the package, as

contrasted with writing from a pen or magic marker subsequent to the constructing.

**6. Paragraph 13 of the Office Action, Etc.**

**a. DANFORTH Does Not Teach the Claimed  
"an activity suggested by the ball ..."**

In paragraph 13 of the Office Action, claim 24 has been rejected pursuant to 35 USC Sec. 102(b). The Examiner contends that the claim is anticipated by DANFORTH, which "discloses a object in a container, where the container resembles a ball...and the object is a hat..." and "the ball would suggest the activity of using the hat since it can be clearly seen that there is a hat...in the ball."

First, the Examiner is contending that the hat is suggestive, but the claims require that the ball is suggestive. DANFORTH does not teach the claimed "activity suggested by the ball...."

Second, the Examiner is misinterpreting the claims in contending that DANFORTH teaches the activity of 'using the hat'; in accordance with the Examiner's interpretation of the claim, DANFORTH teaches *use of the hat... while engaged in the activity of using the hat suggested by the ball*. This interpretation of the claim cannot be correct because the claims positively recite both the "activity" and the "use", and thus they cannot be construed as the same element. Further, there can be no anticipation from a disclosure of less than all elements required in the claim.

**7. Paragraph 14 of the Office Action, Etc.**

**a. GILSTRAP Does Not Teach the Claimed  
"an object in a container ..." etc.**

In paragraph 14 of the Office Action, claim 24 has been rejected pursuant to 35 USC Sec. 102(b). The Examiner contends that the claim is anticipated by GILSTRAP for teaching an object in a container and that the "ball would suggest the activity of using the hat because the user would know that inside the ball there was a hat."

The Examiner's contention is respectfully traversed. First, GILSTRAP teaches a hat having a visor with fold lines to be tucked into the interior of the hat to form a purse. See abstract. Thus, GILSTRAP teaches that the object (the hat) and the container (the purse) are the same element, while the claim positively recites both the "object" and the "container" as separate elements. Further, there can be no

anticipation from a disclosure of less than all elements required in the claim. Although GILSTRAP does mention that the purse can carry any other article that will fit in the purse, there is no indication that GILSTRAP has discovered or contemplated the claimed "an activity suggested by the ball..." → *disc. of ball*

Second, the purse does not resemble a ball except by virtue of the Examiner's hindsight. *Fig. 3*

Third, the Examiner has misconstrued the claim with the concept that "the user would know that inside the ball there was a hat." What the user knows is inside has no bearing whether the claimed "ball is sufficiently detailed to suggest a use of the object during inclement weather while engaged in an activity suggested by the ball..."

Fourth, the Examiner has further misconstrued the claim in that if wearing the hat is the claimed "activity" then what "use" is disclosed--a proper claim interpretation includes all positively recited elements, and an anticipation requires a reference showing all the elements. *proper claim interpretation*

In sum, the GILSTRAP, GELINAS, AGAPIOU, and DANFORTH do not anticipate the claimed invention, and further, the anticipation rejections appear to be premised on a misconstruction of the claims, if the Office Action has been correctly understood.

Again, respectfully, the Office Action is not particularly clear in certain respects, and if there is a misunderstanding based on the Office Action, an opportunity to respond to a correct understanding is requested.

**8. Paragraph 16 of the Office Action, Etc.**

In paragraph 16 of the Office Action, claims 5, 10, and 24 have been rejected pursuant to 35 USC Sec. 103. The Examiner contends that the claims are obvious in view of SWATEK.

The Examiner's contention is respectfully traversed. First, the Examiner contends that "SWATEK discloses a process of making a package with an article located inside" but SWATEK is a design patent—SWATEK does not disclose a process. This is an important distinction because the instant claims require a process in which an article shaped differently than the shape of the packaging, is marketed along with the package. There is nothing other than the Examiner's hindsight speculation as to the

shape of any object in the container of SWATEK and there is nothing other than the Examiner's hindsight speculation as to a marketing of a combination. At best one might guess exactly along the lines of the Examiner: "the package is a replica of a first aid item," (a band aid?). If the guess were true, because a band aid is the same shape as the container, SWATEK would still not disclose the claimed element. Further, SWATEK does not disclose "marketing the article with the package to suggest the use of the article." It is respectfully submitted that the Examiner is merely speculating as to the shape of the contents in the SWATEK container and its combined marketing. Evidence beyond the Examiner's speculation is required for withholding a patent, in particular, evidence of the shape of the contents of the SWATEK container and of the marketing of the container in combination with the so-shaped contents. → *done by Mark*

Second the Examiner contends that while SWATEK does not disclose the shape of charge cards or a life preserver, "it would have been obvious to change the shape of the replica [of a band aid]... to a charge card or life preserver...." It is respectfully submitted that the Examiner's contention, if true, would end all design patent law. The Examiner is required to show, by a reference or his affidavit, that such a design choice was known. → *isn't it?*

**9. Paragraph 17 of the Office Action**

In paragraph 17 of the Office Action, the Examiner has indicated that claims 6-7 would be allowable if rewritten to include the language of the underlying base claim and any intervening claims. } *isn't it?*

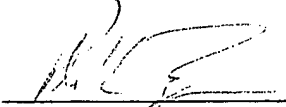
In response, these claims have been cancelled and rewritten as new claims 25-26. The courtesy of the Examiner's guidance is appreciated.

**III. CONCLUSION**

The application, as amended, is believed to be in condition for allowance, and favorable action is requested. If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

Respectfully submitted,

Date: 29 July 1999

  
Peter K. Trzyna  
(Reg. No. 32,601)

P.O. Box 7131  
Chicago, IL 60680-7131

(312) 240-0824